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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,704	12/27/2001	Thomas E. Murphy	BS01-286	9260
38516	7590	08/08/2006	EXAMINER	
SCOTT P. ZIMMERMAN, PLLC PO BOX 3822 CARY, NC 27519			VAN HANDEL, MICHAEL P	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/026,704	<b>Applicant(s)</b> MURPHY ET AL.	
	<b>Examiner</b> Michael Van Handel	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 19-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. This action is responsive to an Amendment filed 6/20/2006. Claims **19-31** are pending. Claims **19-23, 25-30** are amended. Claims **1-18** are canceled.

### *Response to Arguments*

1. Applicant's arguments filed 6/20/2006 with respect to claim **19-31** have been considered, but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **19-21, 23-28, 30, 31** are rejected under 35 U.S.C. 102(e) as being anticipated by  
----- DeWeese et al. -----

Referring to claims **19** and **30**, DeWeese et al. discloses a set top box integrated with, or communicating with, a television, the set top box comprising:

- a first input receiving an audio signal (p. 3, paragraph 56);
- a first output adapted to be received by the television (p. 4, paragraph 65 & Fig. 1A);

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- a second output adapted to be received by a second set top box (p. 3, paragraph 57);
- a second input adapted to receive audible message information (p. 9, paragraph 105 & Fig. 10); and
- a back channel communications path that is different from the first input (the examiner notes that the chat server 88 is connected to television distribution facility 16 via communications network 86, so the back channel path is different from the first input)(p. 5, paragraph 71 & Fig. 2A), wherein a volume of the audio signal is reduced below a volume of the audible message information (the examiner notes that in canceling out audio from the current TV program the volume of the audio signal is reduced below that of the audible message information)(p. 9, paragraph 102).

Referring to claims **20** and **21**, DeWeese et al. discloses a set top box according to claims 19 and 30, respectively, wherein the message information comprises at least one of video information, text information, and a pre-formatted message (the examiner notes that chat sessions can have text, audio, video, or a combination, as well additional appended information)(p. 3, paragraph 55; p. 4, paragraph 64; & p. 14, paragraph 141).

NOTE: The USPTO considers the applicant's "at least one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claim **24**, DeWeese et al. discloses the set top box according to claim 19, wherein the message information is retrieved from a memory device (p. 5, paragraph 69).

Referring to claims **23** and **25**, DeWeese et al. discloses the set top box according to claims 30 and 19, respectively, further comprising a memory storing pre-made voice messages

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(the examiner notes that chat sessions can be stored and viewed at a later time)(p. 4, paragraph 64).

Referring to claim **26**, DeWeese et al. discloses the set top box according to claim 19, further comprising a message waiting indicator (the examiner notes that when a message is received it appears in region 206)(p. 8, paragraph 93 & Fig. 9).

Referring to claims **27** and **31**, DeWeese et al. discloses the set top box according to claims 19 and 30, respectively, further comprising another input adapted to receive information from a keyboard (p. 5, paragraph 67 & Fig. 1B).

Referring to claim **28**, DeWeese et al. discloses the set top box according to claim 19, wherein the first input also receives a video signal (p. 3, paragraph 56) and the set top box modifies the video signal to display a text message (p. 8, paragraph 93 & Fig. 9).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims **22**, **29** are rejected under 35 U.S.C. 103(a) as being unpatentable over DeWeese et al. in view of Mimura et al.

Referring to claims **22** and **29**, DeWeese et al. discloses a set top box according to claims 30 and 19, respectively, wherein the audio content is processed for an audio channel. DeWeese

et al. does not disclose processing the audible message information for another audio channel. Mimura et al. discloses a TV conferencing system that allows a user to receive video and audio from multiple communication partners simultaneously. Sounds corresponding to the image are reproduced from rear or side wall loudspeakers (col. 14, l. 37-48). Mimura et al. further discloses receiving multiple sounds simultaneously and localizing the sounds based on the locality of a displayed video image (col. 20, l. 22-62 & Figs. 32A-33). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify DeWeese et al. to include processing multiple received audio messages to be output from different speakers, such as that taught by Mimura et al. in order to draw a user's attention to a message.

### *Conclusion*

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571.272.5968. The examiner can normally be reached on Monday-Friday, 8:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571.272.7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Van Handel  
Examiner  
Art Unit 2623

MVH

  
CHRIS KELLEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600